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**OFFICE OF PETITIONS**

In re Application of :  
McKeon :  
Application No.09/538,106 : NOTICE  
Filed: 29 March, 2000 :  
Attorney Docket No. HMV-038.02 :  
:

This is a notice regarding the request for acceptance of a fee deficiency submission (properly considered under 37 C.F.R. §1.28) filed via FAX on 23 April, 2004.

The Office regrets the delay in addressing this matter.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 C.F.R. §1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc., No. 97-1128, -1280, -1453, 1998 U.S. App. LEXIS 21409, at \*30 (Fed. Cir. Sept. 1, 1998).

Therefore, the fee deficiency submission (schedule of fees) under 37 C.F.R. 1.28<sup>1</sup> is hereby

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<sup>1</sup> The regulations at 37 C.F.R. §1.28 provide:

**§ 1.28 Refunds when small entity status is later established; how errors in small entity status are excused.**

(a) *Refunds based on later establishment of small entity status.* A refund pursuant to § 1.26, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27© and a request for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. The three-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within three months of the date of payment of, the full fee.

**ACCEPTED.**

The fees are charged as authorized to Deposit Account 06-1448, HMV-038.02.

This file (in IFW) is released to the Examiner in Technology Center 1600 for further processing.

Inquiries related to this communication should be directed to the undersigned at (703) 305-9199.

John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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(b) *Date of payment.*

- (1) The three-month period for requesting a refund, pursuant to paragraph (a) of this section, starts on the date that a full fee has been paid;
- (2) The date when a deficiency payment is paid in full determines the amount of deficiency that is due, pursuant to paragraph © of this section.

© *How errors in small entity status are excused.* If status as a small entity is established in good faith, and fees as a small entity are paid in good faith, in any application or patent, and it is later discovered that such status as a small entity was established in error, or that through error the Office was not notified of a loss of entitlement to small entity status as required by § 1.27(g)(2), the error will be excused upon: compliance with the separate submission and itemization requirements of paragraphs (c)(1) and (c)(2) of this section, and the deficiency payment requirement of paragraph (c)(2) of this section:

(1) *Separate submission required for each application or patent.* Any paper submitted under this paragraph must be limited to the deficiency payment (all fees paid in error), required by paragraph (c)(2) of this section, for one application or one patent. Where more than one application or patent is involved, separate submissions of deficiency payments (*e.g.*, checks) and itemizations are required for each application or patent. See § 1.4(b).

(2) *Payment of deficiency owed.* The deficiency owed, resulting from the previous erroneous payment of small entity fees, must be paid.

(I) *Calculation of the deficiency owed.* The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment. The total deficiency payment owed is the sum of the individual deficiency owed amounts for each fee amount previously erroneously paid as a small entity. Where a fee paid in error as a small entity was subject to a fee decrease between the time the fee was paid in error and the time the deficiency is paid in full, the deficiency owed is equal to the amount (previously) paid in error;

(ii) *Itemization of the deficiency payment.* An itemization of the total deficiency payment is required. The itemization must include the following information:

(A) Each particular type of fee that was erroneously paid as a small entity, (*e.g.*, basic statutory filing fee, two-month extension of time fee) along with the current fee amount for a non-small entity;

(B) The small entity fee actually paid, and when. This will permit the Office to differentiate, for example, between two one-month extension of time fees erroneously paid as a small entity but on different dates;

(C) The deficiency owed amount (for each fee erroneously paid); and

(D) The total deficiency payment owed, which is the sum or total of the individual deficiency owed amounts set forth in paragraph (c)(2)(ii)(C) of this section.

(3) *Failure to comply with requirements.* If the requirements of paragraphs (c)(1) and (c)(2) of this section are not complied with, such failure will either: be treated as an authorization for the Office to process the deficiency payment and charge the processing fee set forth in § 1.17(l), or result in a requirement for compliance within a one-month non-extendable time period under § 1.136(a) to avoid the return of the fee deficiency paper, at the option of the Office.

(d) *Payment of deficiency operates as notification of loss of status.* Any deficiency payment (based on a previous erroneous payment of a small entity fee) submitted under paragraph © of this section will be treated under § 1.27(g)(2) as a notification of a loss of entitlement to small entity status.

[47 Fed. Reg. 40140, Sept. 10, 1982, added effective Oct. 1, 1982; para. (a), 49 Fed. Reg. 553, Jan. 4, 1984, effective Apr. 1, 1984; para. (d)(2), 57 Fed. Reg. 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. © revised, 58 Fed. Reg. 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (a) revised, 60 Fed. Reg. 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a) & © revised, 62 Fed. Reg. 53131, Oct. 10 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]